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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,666	03/24/2004	Josef Balcer	0018138.00030	6219
21878	7590	04/29/2005	EXAMINER	
KENNEDY COVINGTON LOBDELL & HICKMAN, LLP 214 N. TRYON STREET HEARST TOWER, 47TH FLOOR CHARLOTTE, NC 28202			BLAU, STEPHEN LUTHER	
		ART UNIT		PAPER NUMBER
				3711
DATE MAILED: 04/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/808,666	BALCER, JOSEF	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3,11 and 12 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-10 and 13-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/15/04, 6/23/04, 6/25/05</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

1. Claim 3, and 11-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6 April 2005.

Information Disclosure Statement

2. The information disclosure statements filed 15 June 2004, 23 June 2004, and 25 January 2005 fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because for the "Other Documents" in each of these information disclosure statements there are no dates. The examiner cannot determine if these documents are prior art or not. It has been placed in the application file, but the information referred to therein for these noted references have not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

3. The information disclosure statements filed 23 June 2004 and 25 January 2005 fail to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The German Search Report in IDS filed 23 June 2004 and DE 9105505.9 U in IDS filed 25 January 2005 to not contain an English explanation. The information disclosure statements have been placed in the application file, but the information referred to therein for these noted references have not been considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 requires a shaft being oriented at an angle of at least 10 degrees from perpendicular to a sole yet the claim it depends on (Claim 1) requires a shaft being oriented substantially perpendicular to a sole. It is uncertain in claim 2 what the orientation is.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams.

Williams discloses a shaft being oriented substantially perpendicular to a sole in the form of the front edge of the sole (Fig. 3, 9), a face extending substantially parallel to an axis of a shaft (Figs. 3-4, 9), an upper end being at a level of a golfer's chest with the shaft able to be positionable along one arm of the golfer, an upper end of a shaft being in a region of a golfer's armpit (Figs. 7-8), a shaft is attached to a head at least approximately centrally between end of the impact face that are essentially parallel to an axis of a shaft (Figs. 1, 3, 5, 8), and a back side (Ref. No. 14, Fig. 3) facing away from an impact face and forming an impact face that is inclined relative to an axis of a shaft (Fig. 3).

8. Claims 1-2, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Florian.

Florian discloses a shaft being oriented at an angle of at least 10 degrees from perpendicular to a sole (Figs. 1 and 3-4, claim 5), a face extending substantially parallel

to an axis of a shaft (Fig. 4), an upper end being at a level of a golfer's chest with the shaft able to be positionable along one arm of the golfer, and an upper end of a shaft being in a region of a golfer's armpit (Fig. 1).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Murray.

Williams lacks a variable length putter, a shaft having two adjustable parts relative to one another in the direction of the axis of the shaft and fixable to one another in a set position. Murray discloses a variable length putter, a shaft having two adjustable parts relative to one another in the direction of the axis of the shaft and fixable to one another in a set position (Fig. 4) in order to shorten a shaft prior to transportation and in order to match an individual's physiology (Col. 1, Lns. 50-57). In view of the patent of Murray it would have been obvious to modify the putter of Williams to have a variable length putter, a shaft having two adjustable parts relative to one another in the direction of the axis of the shaft and fixable to one another in a set

position in order to shorten a shaft prior to transportation and in order to match an individual's physiology.

11. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Sundin in view of Hong.

Williams lacks a side face being an impact face inclined relative to the axis of a shaft, and a back face being an impact face inclined relative to the axis of a shaft.

Sundin discloses a shaft oriented perpendicular to a sole with front face parallel to an axis of a shaft and a back face being an impact face inclined relative to the axis of a shaft (Figs. 2-3) in order to use a club as either a putter or chipper (Col. 1, Lns. 1-8).

Hong discloses a golf club head having a side face being an impact face inclined relative to the axis of a shaft and a back face being an impact face inclined relative to the axis of a shaft in order to have multiple striking faces for a head (Col. 2, Lns. 50-52).

In view of the patent of Sundin it would have been obvious to modify the putter of Williams to have a shaft oriented perpendicular to a sole with front face parallel to an axis of a shaft and a back face being an impact face inclined relative to the axis of a shaft in order to use a club as either a putter or chipper using the swing of Williams. In view of the patent of Hong it would have been obvious to modify the putter of Williams to have a side face being an impact face inclined relative to the axis of a shaft in addition to a back and front impact faces in order to have multiple striking faces for a head using the swing of Williams.

12. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Florian.

Williams discloses a conventional long shafted putter being about 50 inches and a two piece grip (Figs. 7-8).

Williams lacks a grip on a shaft extending from the upper end of the shaft a distance of approximately 60-70 cm from a head. Florian discloses a side putter with a shaft end pivoted near the chest of a player with a shaft being 40-50 inches in length and a grip extending to approximately the midpoint of a club (Fig. 1). In view of the patent of Florian it would have been obvious to modify the club of Williams to have a grip on a shaft extending from the upper end of the shaft a distance of approximately 60-70 cm from a head in order to provide comfort to both hands placed on a club when putting.

13. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Florian or Leek.

Williams discloses golfer's arm crossing in front of a chest (Figs. 7-8). Williams does not specifically state that the arm is against the chest but clearly one skilled in the art would have selected a suitable location of the arm in which against the chest is included.

Williams lacks one arm against the chest and holding the upper end of a putter as a pivot point. Florian (Fig. 6) or Leek (Figs. 1, 3) disclose a method of holding the upper end of a putter as a pivot point while swing a club with the other arm in order to

produce a pendulum type of motion (Col. 8 Ln. 68 through Col. 9, Ln. 1). In view of the patents of Florian or Leek it would have been obvious to modify the method of Williams to have a method of holding the upper end of a putter as a pivot point while swing a club with the other arm in order to produce a pendulum type of motion.

It would have been obvious to modify the method of putting of Williams to have one arm against the chest in order to provide support to the arm holding the end of the shaft so the arm does not get tired.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Florian or Leek as applied to claims 15-16 above, and further in view of Examiner's Official Notice.

The Examiner takes Official Notice that it is well known in the golf art to remove a ball from a hole after putting if the ball goes in.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is

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(703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 26 April 2005


STEPHEN BLAU
PRIMARY EXAMINER